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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,108	07/25/2000	Steven D. Barnes	END92000 0026US1	7350

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,108

Applicant(s)

BARNES ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 27, 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of Claims

1. Due to communications filed 7/25/00, the following is a non-final, first office action. Claims 1-30 were pending in this application. Claims 1-30 were subjected to a restriction requirement and due to the election made by the attorney, claims 1-6, 13-26, 28 and 29 are now pending. Claims 1-6, 13-26, 28 and 29 are rejected as follows.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-6, 13-26, 28 and 29, drawn to defining, measuring, monitoring and controlling engagements, classified in class 705, subclass 7.
 - II. Claims 7-8 and 27, drawn to the development of new business models, classified in class 705, subclass 1.
 - III. Claims 9-12 and 30, drawn to bidding, classified in class 705, subclass 37.
3. The inventions are distinct, each from the other because of the following reasons:
- Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as analyzing a model in order to measure, monitor and control engagements. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention II has separate utility such as developing new models from existing data. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as analyzing a model in order to measure, monitor and control engagements. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Shelley Beckstrand on 10/13/03, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 13-26, 28 and 29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-12, 27 and 30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 13-15, 17, 26, 28, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Guheen et al.

As per claim 1, Guheen et al discloses:

in a first phase, defining an engagement model which will be used to address a market place requirement, (Col. 98, lines 63-67, Col. 175, lines 28-32, [data modeling tool chosen by the engagement team, allowing a competitive electronic commerce marketplace]);

in a second phase, utilizing said engagement model to create an engagement template which specifically addresses client requirements within said market place, (Col. 110, lines 44-46, Col. 171, lines 51-62, Col. 274, lines 9-17 and lines 41-59,

[standard design templates, requirements of one or more successive parties, templates which reflect general requirements corresponding to that user]);

and in a third phase, measuring, monitoring and controlling client engagements based upon said engagement model, (Col. 90, lines 48-54, planning/designing, monitoring and interfacing with the change control system)).

As per claim 2, Guheen et al discloses:

said first phase further comprising the steps of:

enabling a generic engagement model for addressing said market place requirements, (Col. 177, lines 30-31 and line 40, [where generic content model id shown to contribute to the configurability of the invention]; and

generating work product descriptions specified by said engagement model, (Col. 182, lines 60-65, Col. 128, lines 26-28, [description of product, brief description of the product])).

As per claim 4, Guheen et al discloses:

said second phase further including the steps of:

creating an engagement template personalized to a specific client engagement from said engagement model, (Col. 210, lines 32-35, [custom template based publishing]);

creating attack, resource, and deployment plans for said specific client engagement using said engagement template, (Col. 17, see Product4 Product Suite, Product4 SPF-200, [protecting an organization from internet attacks], Col. 73, lines 47-51, [network assessment for preventing an attack on the network], Col. 38, lines 3-4,

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[ensuring resources are used effectively]. Col. 23, [See Other Business2 Products, Process Manager where the development and deployment of processes are supported]).

As per claims 13, 17, Guheen et al discloses:

a set of process descriptions/said process description describing how to develop said specific project, (Col. 41, lines 31-38, [developing a process description]);

a set of work product descriptions/said work product descriptions describing what to develop for a specific project and (Col. 182, lines 60-65, Col. 128, lines 26-28, [description of product, brief description of the product]).

at least one engagement model collecting at least one said process description and at least one said work product description into a model for implementing a typical project addressing a type of marketplace requirement, (Col. 98, lines 63-67, Col. 175, lines 28-32, [data modeling tool chosen by the engagement team, allowing a competitive electronic commerce marketplace]).

As per claim 14, Guheen et al discloses:

at least one engagement family including a plurality of said engagement models for addressing a family of typical projects, (Col. 31, lines 55-57, [family of related programs]).

As per claim 15, Guheen et al discloses:

a plurality of work product descriptions organized into a plurality of domains, each said domain being a logical grouping of said work product descriptions, (Col. 31, lines 57-64, [specific problems in a given domain]).

As per claim 26, Guheen et al discloses:

A program storage device readable by a machine, tangibly embodying a program of instructions executable by a machine to perform method steps...(Col. 292, lines 19-21, [computer program embodied on a computer readable medium]):

in a first phase, defining an engagement model which will be used to address a market place requirement, (Col. 98, lines 63-67, Col. 175, lines 28-32, [data modeling tool chosen by the engagement team, allowing a competitive electronic commerce marketplace]);

in a second phase, utilizing said engagement model to create an engagement template which specifically addresses client requirements within said market place, (Col. 110, lines 44-46, Col. 171, lines 51-62, Col. 274, lines 9-17 and lines 41-59, [standard design templates, requirements of one or more successive parties, templates which reflect general requirements corresponding to that user]);

and in a third phase, measuring, monitoring and controlling client engagements based upon said engagement model, (Col. 90, lines 48-54, planning/designing, monitoring and interfacing with the change control system)).

As per claim 28, Guheen et al discloses:

A computer program product or computer program element configured to be operable responsive to a customer having requirements for executing process steps for defining an engagement...(Col. 292, lines 19-21, [computer program embodied on a computer readable medium]):

utilizing said engagement model to create an engagement template which specifically addresses client requirements within said market place, (Col. 110, lines 44-46, Col. 171, lines 51-62, Col. 274, lines 9-17 and lines 41-59, [standard design templates, requirements of one or more successive parties, templates which reflect general requirements corresponding to that user]);

and measuring, monitoring and controlling client engagements based upon said engagement model, (Col. 90, lines 48-54, planning/designing, monitoring and interfacing with the change control system)).

As per claim 29, Guheen et al discloses:

An article of manufacture comprising:

a computer useable medium having computer readable program code means embodied therein...(Col. 292, lines 19-21, [computer program embodied on a computer readable medium]):

computer readable program code means for causing a computer to effect providing a set of process descriptions, (Col. 41, lines 31-38, [developing a process description]);

computer readable program code means for causing a computer to effect providing a set of work product descriptions, (Col. 182, lines 60-65, Col. 128, lines 26-28, [description of product, brief description of the product]).

computer readable program code means for causing a computer to effect providing at least one engagement model collecting at least one said process description and at least one said work product description into a model for implementing

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a typical project addressing a type of marketplace requirement, (Col. 98, lines 63-67, Col. 175, lines 28-32, [data modeling tool chosen by the engagement team, allowing a competitive electronic commerce marketplace])).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 5, 6, 16, 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al (US 6,615,166), and further in view of Bowman-Amuah (US 6,615,199).

As per claim 3 Guheen et al fails to disclose the following, however Bowman-Amuah discloses:

said generic engagement mode including definitions of best practices and reusable assets, (Col. 25, lines 3-4, [best practices], Col. 124, lines 66-67, [reusable, enterprise software assets])).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include definitions of best practices and reusable assets with the motivation of giving the option to utilize methods that would optimize the engagement process.

As per claim 5, Guheen et al fails to disclose the following, however Bowman-Amuah discloses:

said third phase further including the step of:
cyclically redefining said engagement template while deploying said work product descriptions and process descriptions to said client engagement, (Col. 189, lines 55-62, [redefining]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use cyclical redefinition with the motivation of constantly having definitions available for use when completing engagement processes.

As per claim 6, Guheen et al discloses:
said third phase further including the steps of:
monitoring performance of said client engagement, (Col. 157, lines 5-8, [monitor and correct system's performance]);

and based upon said performance, allocating resources to further attack said marketplace requirement, (Col. 157, lines 11-14, [forecasting future requirements and providing input into the financial planning process]).

As per claim 16, Guheen et al discloses:
said domains including an application domain, (Col. 30, lines 22-26, [specific application domain]), an architecture domain, (Col. 152, lines 45-54, [old and new architecture domains]), a business domain, (Col. 96, lines 36-42, [business components isolated to reflect the analysis performed in the domain]),

Guheen fails to disclose the following, however Bowman –Amuah discloses:

an engagement domain, (Col. 184, lines 59-67, component engagements in the domain model], an organization domain, (Col. 128, lines 27-32, [organization business domain]), and an operations domain, (Col. 281, lines 27-32, domain object for an operation).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to incorporate an engagement domain, an organization domain and an operations domain with the motivation of writing the proper attributes to the correct process.

As per claim 20, Guheen et al discloses:

said application domain organizing work product descriptions relating to the design, development and testing of computer software components, applications and systems, (Col. 30, lines 26-30, [specific application domain]).

As per claim 21, Guheen et al discloses:

said architecture domain organizing work product descriptions relating to the architecture of an information technology system for addressing business and infrastructure requirements, (Col. 152, lines 45-54, [rollout planning in an architecture domain]).

As per claim 22, Guheen et al discloses:

said business domain organizing work product descriptions relating to the structured investigation of current and desired situations with a client' business, (Col. 96, lines 62-67, [data modeling for graphically developing the logical and physical data requirements]).

As per claim 23, Guheen et al fails to disclose the following, however, Bowman-Amuah discloses:

said engagement domain organizing work product descriptions relating to project management and technical delivery for projects worldwide, (Col. 184, lines 59-67, component engagements in the domain model]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize an engagement domain with the motivation of producing optimal organization for engagement processes.

As per claim 24, Guheen et al fails to disclose the following, however, Bowman-Amuah discloses:

Said organization domain organizing work product descriptions relating to technology based business transformations using systematically defined organization analysis and design and change management practices, (Col. 128, lines 27-32, [organization business domain])).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize an organization domain with the motivation of producing optimal organization for organization processes.

As per claim 25, Guheen et al fails to disclose the following, however, Bowman-Amuah discloses:

said operations domain organizing work product descriptions relating to the execution and management of information technology services and resources and to

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the protection of information technology assets, (Col. 281, lines 27-32, domain object for an operation).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize an operations domain with the motivation of producing optimal organization for operation processes.

9. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al (US 6,615,166).

As per claim 18, Guheen et al discloses:

said process descriptions further comprising...task descriptions, (Col. 139, lines 38-43, [task descriptions]).

Guheen et al fails to disclose the following, however the following is obvious with Guheen et al since task descriptions are already disclosed and a task description includes a phase and an activity:

phase descriptions, activity descriptions...

As per claim 19, Guheen et al discloses:

further comprising at least one engagement template derived from one of said engagement models for defining said work product descriptions and said process descriptions for a specific engagement project, (Col. 110, lines 44-46, Col. 171, lines 51-62, Col. 274, lines 9-17 and lines 41-59, [standard design templates, requirements of one or more successive parties, templates which reflect general requirements corresponding to that user]).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ARB

A. R. B.
October 24, 2003


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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